REMARKS

The Office Action provides a number of rejections. We list them here in the order in which they are addressed.

I. Claim 1 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

II. Claims 1, 9 and 11-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Little et al. (U.S. Patent No. 6,207,370) in view of Garvin et al. (U.S. Patent No. 6,329,180).

III. Claims 1, 9 and 11-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Little et al. (U.S. Patent No. 6,207,370) in view of Garvin et al. (U.S. Patent No. 6,329,180) as applied to claims 1, 9 and 11-12 above, and further in view of Elion et al. (*Current Protocols in Molecular Biology*, Unit 3.17, pages 3.17-3.17.10, 1993).

Applicants respond as follows:

I. Claim 1 as written is not indefinite under 35 U.S.C. §112, second paragraph.

Without agreeing with the Examiner, but to further the prosecution, and hereby reserving the right to prosecute the "pre-primer" embodiment in the future, Applicants have amended Claim 1 such that it only recites a "primer."

II. Claims 1, 9 and 11-12 are not unpatentable under 35 U.S.C. §103(a).

The Examiner admits that Little et al. (U.S. Patent 6,207,370) fails to teach a method "wherein the first and second epitope markers are different and wherein the second epitope marker is selected from the group consisting of SEQ ID NOS: 6-9" (Office Action, page 4, lines 11-13). The Examiner then looks to Garvin et al. (U.S. Patent 6,329,180) to remedy this deficiency without demonstrating that Little et al.

recognizes this missing element as a shortcoming by which a skilled artisan would be motivated to look to Galvin et al. The Examiner justifies this combination of references as follows:

> One of ordinary skill in the art would have been motivated to combine the teachings of Little et al. with those of Garvin et al. because Garvin et al. teach that the use of a second tag, different from the first, would allow for a two step purification process that could distinguish between full length protein products and those which were truncated and/or those which were the product of internal translation initiation. This is desirable because both Garvin et al. and Little et al. teach that the mass of the protein could be easily assessed via mass spectroscopy in order to detect protein-altering mutations. *Office Action page 5, line 21 to page 6, line 6.*

Applicants cannot agree that a person of ordinary skill in the art would be motivated to combine Garvin et al. with Little et al. simply because both references teach that protein mass can be determined by mass spectrometry. The Examiner is merely recreating the present invention based on a hindsight-driven combination of references tied together by an irrelevant similarity. Nonetheless, without acquiescing to the rejection, but to further prosecution and hereby reserving the right to prosecute the unamended (or similar) claims in the future, Applicants have amended Claims 1 and 9 to include a sequence coding for a second epitope marker in the first oligonucleotide primer. To preserve proper antecedent basis the second oligonucleotide primer now recites a sequence coding for a third epitope marker. These amendments are fully supported throughout the specification, as for example page 44, lines 8-13; and page 46, lines 23-30.

Since the cited references fail to describe each of the elements recited in independent Claims 1 and 9, Applicants respectfully contend that the rejection of Claims 1, 9 and 11-12 should be withdrawn.

III. Claims 1, 9 and 11-13 are not unpatentable under 35 U.S.C. §103(a) further in view of Elion et al.

Based on the amendments and arguments provided above relating to the Little et al. and Garvin et al. references, Applicants likewise contend that the rejection of Claims 1, 9 and 11-13 should be withdrawn.

CONCLUSION

Based on the arguments provided above, Applicants believe that Claims 1, 9 and 11-13 are in condition for allowance. Should the Examiner believe a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned at 781.828.9870.

Respectfully submitted,

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